

REMARKS

The application has been amended and is believed to be in condition for allowance. A telephonic interview is requested should there be any remaining issues that preclude the application from proceeding to issue.

Claims 27-54 were examined..

Applicants acknowledge with appreciation that claims 28 and 41 were indicated to be directed to allowable subject matter.

The previously pending claims have been replaced with a new claim set based on the prior claims and additional features discussed below.

New claim 55 can be seen as a combination of former claims 27 and 32. New claim 67 is changed with respect to former claim 40 in a similar manner. The dependent claims 56-66 and 68-78 refer to claims 55 and 67 respectively in a similar way as did claims 28-39 and 41-52 did before to claims 27 and 40 respectively.

Claims 56, 68, 80 and 82 correspond to allowable subject matter of claims 28/41.

Formal Matters

Claims 53-54 were rejected under section 101 as being directed to non-statutory subject matter.

These claims have been replaced with claims 79-82 in a form believed to be fully compliant with section 101. Withdrawal of this rejection is there solicited. However, should there be

any remaining issues as to these claims and section 101, it is requested that the claims be examined substantively and that the Examiner suggest amendments to the claims so as to meet the section 101 standard.

Substantive Matters

Claims 27, 29-31, 39-44, and 52-54 stand rejected as obvious over UHL 6,292,709 in view of HIGGINS 5,754,671.

Claims 32-37 and 45-50 stand rejected in further view of BYRD 5,832,480.

Claims 38 and 51 stand rejected in further view of CIANFROCCA 6,088,796.

The new claim set has been drafted to recite the invention in a manner non-obvious over the prior art. Applicants have carefully studied UHL, HIGGINS, BYRD, and CIANFROCCA.

As stated by MPEP §706.02(j), to establish a *prima facie* case of obviousness the Official Action must first, consider the relevant teachings of the prior art, and after determining the differences between the pending claim and the prior art teachings, second, propose modifications of the prior art necessary to arrive at the claimed subject matter, explaining the motivation for combining the particular references and making the proposed modifications to those references. Thus, there must be motivation to modify the references and a teaching or suggestion of **all** the claim recitations.

Thus, in the pending obviousness rejection the analysis starts with UHL and then one considers how UHL might be modified taking into account what HIGGINS, BYRD, and CIANFROCCA fairly teach and what modifications might be motivated as a result of those teachings.

This approach is consistent with the Federal Circuit statement that "[m]ost, if not all, inventions are combinations and mostly of old elements." *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*In re Rouffett* at 1458).

So the required analysis is not what is possible by pasting together pieces of the prior art, but rather, when starting with UHL and then one considers how UHL might be

modified taking into account what HIGGINS, BYRD, and CIANFROCCA fairly teach and what modifications are motivated as a result of those teachings.

New claim 55 emphasizes a major difference between UHL and the present invention.

In the invention, there are two recited statistical analysis; that is, quality rating and the comparison score. Further, the comparison score is a second statistic derived apart from the first statistic of the quality rating.

E.g., see claim 55 reciting:

i) to determine a quality rating for the address data as scanned from an item of post on the basis of predefined criteria, the quality rating being indicating how good the address data are,

ii) to derive a name for an addressee from the name lines, to derive an address for the addressee from the address data, to read registered names of persons residing at that address from the address database and to compare these with the name of the addressee and, on the basis of that comparison, to determine a comparison score per registered name, the comparison score having a higher value the greater the degree of correspondence between the name of the addressee and a respective registered name, the comparison score being derived apart from the quality rating.

None of the references teach, or would be modified to teach, this approach (taking into account the claim as a whole).

UHL discloses a method and device for the online processing of mail items to be forwarded in which address data are recorded in a forwarding database, i.e. they are predetermined. To that effect, UHL discloses a two-step method (column 4, lines 8 to column 5, line 10):

UHL reads the address block on the mail by an OCR apparatus; the result is improved by using a first comparator 216 that compares the read result with a name address data bank (or "dictionary"). This step delivers an OCR result with improved recognition (column 4, line 17). Based on the result of step 1, a second comparison is made, i.e., a database is consulted that stores information as to two possible amendments of the addressee address:

- 1) the post item should be forwarded to another address where this new address is stored in a forwarding directory; and
- 2) the post item should be returned to the sender of the post item.

In step 1 a "credibility evaluation" (column 4, line 12) is made. Both options as disclosed in step 2 are related to data regarding the relation between the addressee and the address as present on the mail item.

However, in step 2, UHL does not disclose to use any statistical analysis at all. UHL discloses a simple comparison step with a "yes" or "no" outcome.

As explained on page 10 of the description of the present application, the present invention includes a comparison step in which statistics are involved, thus resulting in a "comparison score" that is a second statistically derived parameter apart from the "quality rating".

Moreover, it is observed that HIGGINS does not disclose anything that is relevant to this second step since HIGGINS is not concerned with the relation between addressee and address on the mail item. HIGGINS is only concerned the correctness of the "words" recognized by an OCR system (where a word comprises characters that may include only numbers like in a zip code).

Thus, the prior art fails to teach or suggest this feature of the invention.

Claim 55 is amended to further clarify the differences with the prior art. The installation as now claimed in new claim 55 comprises the following features:

to determine a quality rating for the address data as scanned from an item of post on the basis of predefined criteria, the quality rating indicating how good the address data are,

to derive a name for an addressee from the name lines, to derive an address for the addressee from the address data, to read registered names of persons residing at that address from

the address database and to compare these with the name of the addressee and, on the basis of that comparison, to determine a comparison score per registered name, a comparison score having a higher value the greater the degree of correspondence between the name of the addressee and a respective registered name, and

to update statistical data relating to said address records stored in said database memory (44), and

to update the content of the database memory (44) on the basis of a rule-based system taking into account the quality rating, the comparison score, and said statistical data.

The second item above relates to determining a comparison score. As the Official Action observed as to former claim 32, neither UHL nor HIGGINS teach to determine such a comparison score.

The Official Action urged that such a comparison score would be disclosed by BYRD, and that a combination from UHL, HIGGINS and BYRD is obvious to a person skilled in the art. Applicants respectfully disagree.

BYRD is not seen as teaching or motivating a comparison score per registered name, the comparison score having a higher value the greater the degree of correspondence between the name of the addressee and a respective registered name, the comparison score being a statistically derived parameter apart from the quality rating. This recitation is more than what is taught or suggested by BYRD. Thus, applicants believe first there is no

motivation to modified UHL/HIGGINS in view of BYRD and second, even if modified, the UHL/HIGGINS/BYRD combination would not teach this feature.

Recall neither UHL nor HIGGINS are "updating statistical data relating to said address records stored in said database memory (44)" as claimed in the third item.

UHL discloses to enter a new and old recipient address of each return mail in a data bank (column 6, lines 53-55). However, UHL does not disclose to update the content of the database based on the quality rating, the comparison score, and said statistical data. HIGGINS and BYRD also fail to make this teaching.

For each of these reasons, that a combination from UHL, HIGGINS and BYRD would not teach all the features of new claim 55. Consequently, new claim 55 is believed to be non-obvious.

The other independent claims are believed non-obvious for the same reasons.

Applicants believe that the present application is in condition for allowance and an early indication of the same is respectfully requested.

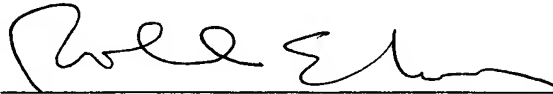
The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any



overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



---

Roland E. Long, Jr. Reg. No. 41,949  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

REL/fb